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Group Art Unit 3774  
U.S. Patent and Trademark Office

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Subject: Petition Under 37 CFR 1.181 For Withdrawal of Finality of Premature Final Rejection for U.S. Patent Application No. 10/757,819

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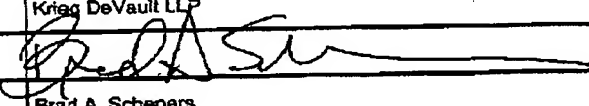
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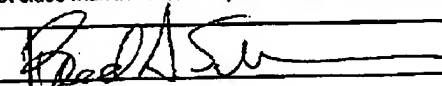
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<b>TRANSMITTAL FORM</b>  (to be used for all correspondence after initial filing)	Application Number	10/757,819	
	Filing Date	January 15, 2004	
	First Named Inventor	Fred J. Molz IV	
	Art Unit	3774	
	Examiner Name	Javier G. Blanco	
Total Number of Pages in This Submission	6	Attorney Docket Number	MSDI-867/PC860.00

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Printed name	Brad A. Schepers	
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re patent application of:	)	Before the Examiner:
Fred J. Molz IV	)	Javier G. Blanco
	)	
Serial No.: 10/757,819	)	Group Art Unit: 3774
	)	
Filed: January 15, 2004	)	Atty Docket: MSDI-667/
	)	PC860.00
	)	
SPINAL IMPLANT CONSTRUCT AND	)	March 5, 2009
METHOD FOR IMPLANTATION	)	

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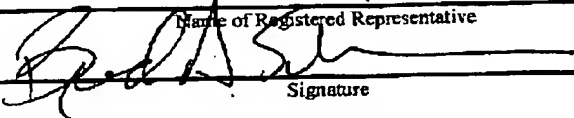
**PETITION UNDER 37 CFR §1.181 FOR WITHDRAWAL  
OF FINALITY OF PREMATURE FINAL REJECTION**

**MAILSTOP PETITIONS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

For the reasons set forth herein, the Applicant submits that the final Office Action dated January 26, 2009 constitutes a premature final rejection, and respectfully requests withdrawal of the finality of the rejection. No fees are believed to be due with regard to the filing of this petition. However, if any fees are deemed necessary, please charge any such fees to Deposit Account No. 12-2424, but not to include any payment of issue fees.

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### REMARKS

The Applicant will address the substantive rejections set forth in the currently outstanding final Office Action via a separate submission. The purpose of this submission is to request withdrawal of the Examiner's holding of finality of the currently outstanding Office Action. Withdrawal of the holding of finality in view of the following remarks is respectfully requested.

### Statement of Facts

A non-final Office Action dated February 26, 2008 set forth various grounds of rejection with regard to each of the pending claims. In particular, dependent claims 27, 33 and 76 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,224,631 to Kohrs, dependent claim 27 was further rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0107519 to Dixon et al., and dependent claim 76 was further rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,099,531 to Bonutti. The Applicant filed a Response to the non-final Office Action on May 27, 2008 (and a Response to Notice of Non-Compliant Amendment on September 23, 2008) wherein various claims, including dependent claims 27, 33 and 76, were rewritten in independent form. However, no amendments were incorporated into rewritten independent claims 27, 33 and 76 (i.e., the scope of rewritten independent claims 27, 33 and 76 did not change).

A final Office Action dated January 26, 2009 set forth various claim rejections, including new grounds of rejection with regard to rewritten independent claims 27, 33 and 76. Specifically, rewritten independent claim 27, 33 and 76 were rejected under 35 U.S.C. §102(b) as being anticipated by newly-cited U.S. Patent No. 6,120,503 to Michelson and newly-cited U.S. Patent No. 6,235,059 to Benezech et al., and as being unpatentable under 35 U.S.C. §103(a) as being unpatentable over newly-cited U.S. Patent No. 5,888,224 to Beckers et al. in view of newly-cited U.S. Patent No. 6,235,059 to Benezech et al. The Applicant further notes that the rejection of rewritten independent claim 33 as being anticipated by U.S. Patent No. 6,224,631 to Kohrs was withdrawn, and the rejection of rewritten independent claim 27 as being anticipated by U.S. Patent Application Publication No. 2002/0107519 to Dixon et al. was also withdrawn. The Applicant submits that the rejections of rewritten independent claims 27, 33 and 76 based on the newly-cited Michelson, Benezech et al. and Beckers et al. references constitute new grounds of rejection that were not necessitated by an amendment to rewritten independent claims 27, 33 and 76 (i.e., claims 27, 33 and 76 were merely rewritten in independent form). Nevertheless, the final Office Action indicated that "Applicant's amendment necessitated the new ground(s) of rejection

presented in this Office action. Accordingly, THIS ACTION IS MADE FINAL. See MPEP § 706.07(a)". (See page 16, item 13).

For the reasons set forth below, the Applicant respectfully disagrees with the holding of finality regarding the current Office Action, and submits that the new grounds of rejection set forth in the final Office Action, at least with regard to rewritten independent claims 27, 33 and 76, were not necessitated by an amendment to claims 27, 33 and 76. Instead, claims 27, 33 and 76 were merely rewritten in independent form, and the scope of rewritten independent claims 27, 33 and 76 did not change. Accordingly, the finality of the Office Action is deemed improper, and withdrawal of the same is respectfully requested.

**Request for Reconsideration**

The Applicant submits that the finality of the outstanding Office Action is improper for at least the following reasons. With regard to making an Office Action final, MPEP §706.07(a) states:

Under present practice, second or any subsequent actions on the merits shall be final, except where the examiner introduces a new ground of rejection that is neither necessitated by applicant's amendment of the claims, nor based on information submitted in an information disclosure statement filed during the period set forth in 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p).

The Applicant submits that the rejections of rewritten independent claims 27, 33 and 76 set forth in the final Office Action dated January 26, 2009 constitutes "a new ground of rejection". Specifically, in the non-final Office Action dated February 26, 2008, dependent claims 27, 33 and 76 were rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,224,631 to Kohrs, dependent claim 27 was further rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent Application Publication No. 2002/0107519 to Dixon et al., and dependent claim 76 was further rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 6,099,531 to Bonutti. However, in the final Office Action dated January 26, 2009, rewritten independent claim 27, 33 and 76 were rejected under 35 U.S.C. §102(b) as being anticipated by newly-cited U.S. Patent No. 6,120,503 to Michelson and newly-cited U.S. Patent No. 6,235,059 to Benezech et al., and as being unpatentable under 35 U.S.C. §103(a) as being unpatentable over newly-cited U.S. Patent No. 5,888,224 to Beckers et al. in view of newly-cited U.S. Patent No. 6,235,059 to Benezech et al. Additionally, the rejection of rewritten independent

claim 33 as being anticipated by U.S. Patent No. 6,224,631 to Kohrs was withdrawn, and the rejection of rewritten independent claim 27 as being anticipated by U.S. Patent Application Publication No. 2002/0107519 to Dixon et al. was also withdrawn. The Applicant submits that the rejection of rewritten independent claims 27, 33 and 76 based on the newly-cited references clearly constitute new grounds of rejection.

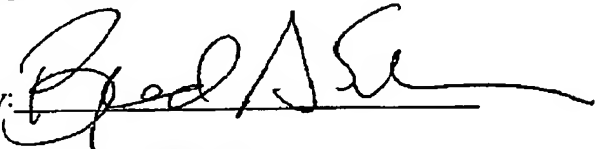
Additionally, the Applicant further submits that the new grounds of rejection set forth in the final Office Action with regard to rewritten independent claims 27, 33 and 76 were not "necessitated by applicant's amendment of the claims". Specifically, in Applicant's Response to the non-final Office Action filed on May 27, 2008 (and the Response to Notice of Non-Compliant Amendment filed on September 23, 2008), the Applicant merely rewrote claims 27, 33 and 76 in independent form, but did not in any way change the scope of these claims. Therefore, the new grounds of rejection set forth in the final Office Action with regard to rewritten independent claims 27, 33 and 76 were not "necessitated by applicant's amendment of the claims", and the Examiner should not have made the current Office Action final in view of these new grounds of rejection.

For at least the reasons set forth above, the Applicant submits that the finality of the current Office Action is improper. Accordingly, the Applicant respectfully requests withdrawal of the holding of finality.

**CONCLUSION**

For the reasons outlined above, the finality of the Office Action dated January 26, 2009 is deemed improper. Accordingly, reconsideration of the holding of finality and withdrawal of the same is respectfully requested.

Respectfully submitted,

By: 

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